

REMARKS

A. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following remarks.

B. Claim Status

Claims 1-19 had been canceled previously. Claims 20-32 and 34, 35 and 37 are pending in this application. Claim 36 has been cancelled.

Claim 20 has been amended to point out that the upper part is made of elastic material and fits tightly on and cover a wearer's torso. Claim 20 has also been amended to recite that the lower part fits tightly along the wearer's thighs. It is submitted that this amendment is fully supported by Figs 1-3, Page 3, last paragraph and Page 4, lines 23-24 "... the sports clothing lies tightly on the player's body..." and Claim 36.

No new matter was entered.

It should be noted that one of the unique aspect of the present invention is the fact that the upper part is made of elastic material that tightly fits the wearer's upper body thereby making it particularly difficult for an opponent to grip hold of the sports clothing and pull it. Also because the fabric is elastic, it exerts only slight resistance to the wearer's mobility. See the paragraph bridges pages 4-5. As will be brought out in more details below, such is not taught or suggested in the cited art.

C. Amendments after final Office Action

The above amendments are made after a final Office Action. The cancellation of Claim 36 and the amendments to Claim 20 simply clarify the intended meanings of an "upper part" of the one-piece sport clothing to cope with an unexpected interpretation taken by the Examiner. It further clarify that "round" with respect to the lower part meant "along" the thigh, i.e., parallel with the thigh, not circumferential around the thigh. The amendments further include a limitation in a previously presented claim which has been considered by the Examiner. Pursuant to 37 CFR 1.116 (b) (1) and (3), these amendments can be admitted and the admission is respectfully requested.

D. Prior Art Rejection

The Examiner had put forward six prior art rejections.
The prior art rejections are as follows:

- (1) Claims 20 and 34-36 had been rejected as being anticipated by Munjone;
- (2) Claims 20 and 25-27 had been rejected as being unpatentable over Sweeney in view of Pedrick;
- (3) Claims 20-24 and 29-31 had been rejected as being unpatentable over Rosenberg in combination with Munjone;
- (4) Claim 28 had been rejected as being unpatentable over Rosenberg and Munjone in combination with Hochman;
- (5) Claim 32 had been rejected as being unpatentable over Rosenberg and Munjone in combination with Green; and
- (6) Claim 37 had been rejected as being unpatentable over Rosenberg and Munjone in combination with Diamond.

As noted above, the limitation of claim 36, wherein the upper part is made of elastic material, has been added to claim 20 (independent claim herein).

It is noted that the Examiner had cited Munjone to teach an upper part. Munjone teaches a pair of shorts which cover the waist. The waist portion of Munjone's shorts was used to anticipate the upper part of the claim. To clarify that the upper part covers the chest, back and extends over the shoulders, Claim 20 has been amended to recited that the upper part covers the torso. It is respectfully submitted that rejection 1 are now moot because of the amendment made to claim 20.

Turning to the combination of Sweeney and Pedrick, the rejection 2 above, it should be noted that Claim 20 now recites that the upper part is made of elastic material which tightly fits on and covers the wearer's torso. Sweeney had been cited to teach the upper part and Pedrick had been cited to teach a tight fitting lower part. Even though Sweeney teaches its upper part can be made of stretchy fabric, these two references do not teach that the upper part should tightly fit the torso. Thus claim 20 is patentable over Sweeney and Pedrick.

Turning to the combination of Rosenberg and Munjone, as in the rejections 3-6 above, neither Rosenberg nor Munjone teaches an upper part to tightly fit the wearer's

torso and being made of highly elastic material. This deficiency is not remedied by either Hochman or Green or Diamond. It is respectfully submitted that rejections 3-6 are now moot because of the amendment made to claim 20.

It is respectfully submitted that the present invention as claimed in claims 20-32 and 34, 35 and 37 as presented herein are patentable over the teachings of the cited references, taken alone or in combination.


E. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:


Donald C. Lucas, 31,275
Attorney for Applicant(s)
475 Park Avenue South, 15th Floor
New York, NY 10016
Tel. # 212-661-8000

DCL/YDC